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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,604	03/23/2004	Gary S. Hess	910.002	2462
23598 7590 06/20/2007 BOYLE FREDRICKSON NEWHOLM STEIN & GRATZ, S.C. 250 E. WISCONSIN AVENUE SUITE 1030 MILWAUKEE, WI 53202			EXAMINER AZAD, ABUL K	
			ART UNIT 2626	PAPER NUMBER
			NOTIFICATION DATE 06/20/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@boylefred.com

## Office Action Summary

Application No.

10/806,604

Applicant(s)

HESS ET AL.

Examiner

ABUL K. AZAD

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/26/04</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. Claims 1-19 are pending in this office Action.

#### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-34 of copending Application No. 10/686,924. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications are directed to similar invention using same steps, therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to element some language without any criticality.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagahara (US 2002/0042790).

As per claim 1, Nagahara teaches, “a method of identifying a translation service in response to a translation request”, the method comprising the acts of:

“registering a plurality of translation services with a moderator” (Fig. 1, element 100 “content distribution terminal” as claimed “moderator” and Fig. 2, elements 40, 42 and 44);

“creating a translator record for a particular work experience of each translation service, the translator record including a plurality of free fields containing data that characterizes the particular work experience of each translation service” (Fig. 6);

“receiving at the moderator a request record from a user, the request record including a plurality of free fields each having an associated identifier indicative of a desired work experience” (Fig. 8); and

“matching data in at least one free field of the translator records with the translation request using at least one of the identifiers” (Fig. 8).

As per claim 2, Nagahara teaches, “displaying a translator record to the translation service, the translator record having the plurality of free fields” (paragraph 0090);

“inputting data indicative of the particular work experience by the translation service into each of the plurality of free fields” (paragraph 0092);

“transmitting the translator record of free fields via an internet connection to the moderator” (paragraph 0116);

“receiving the translator record of free fields at the moderator; and storing the record of free fields” (Fig. 2, element 42).

As per claim 3, Nagahara teaches, “wherein one of the free fields of the translator record prompts the translation service for a language pair identifier indicative of work experience in translating a first language to a second language” (paragraph 0092)

As per claim 4, Nagahara teaches, “wherein the moderator includes a website in communication via an internet connection with the translation service and the user making the translation request” (paragraph 0069).

As per claim 5, Nagahara teaches, “wherein the identifiers input into the free fields of the request record includes a language pair indicative of desired work experience in translating from a first language to a second language” (paragraph 0092).

As per claim 6, Nagahara teaches, “further including the act of displaying each translator record of free fields with at least one free field having data that matches identifiers in one or more of the free fields of the request record, wherein each translator

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record is anonymous in regard to the associated translation service" (paragraphs 0106 and 0107).

As per claim 7, Nagahara teaches, "selecting a displayed translator record of free fields associated with the translation service having data indicative of work experience that matches one or more identifiers in the request record; retrieving from the moderator a contact information for the translation service associated with the selected translator record; and displaying the contact information of the translated service associated with the selected translator record to the user" (paragraphs 0109-0110).

As per claim 9, Nagahara teaches, "wherein one of the free fields of the translator record receives data indicative of a subject matter of the translation service's work experience" (paragraph 0092).

As per claims 10-19, they are interpreted and thus rejected for the same reasons set forth in the rejection of claims 1-8 and 9.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagahara (2002/0042790) as applied to claim 1 above, and further in view of well-known prior art.

As per claim 8, Nagahara does not explicitly teach editing and updating the profile of the translator record. Nagahara does teach to create profile of the translator

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record at moderator. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to edit and update the profile of the translator because one ordinary skill in the art would readily recognized that provides a updated information in the web translation services for proper translation.

***Contact Information***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Abul K. Azad** whose telephone number is **(571) 272-7599**. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Patric Edouard**, can be reached at **(571) 272-7603**.

Any response to this action should be mailed to:

**Commissioner for Patents**

**P.O. Box 1450**


**Alexandria, VA 22313-1450**

Or faxed to: **(571) 273-8300**.

Hand-delivered responses should be brought to **401 Dulany Street, Alexandria, VA-22314** (Customer Service Window).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 10, 2007



Abul K. Azad  
Primary Examiner  
Art Unit 2626